

Remarks/Arguments

Status of Claims

Claims 1 and 149-165 are pending.

Claims 158-162 stand withdrawn.

Claims 1, 149-157 and 163-165 stand rejected.

Claims 1, 149,151 and 153 have been amended without prejudice or disclaimer.

Rejection of Claims 1, 149-157 and 163-165 under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 149-157 and 163-165 stand rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement.

As to claims 1 and 149-150, the Examiner states that the since the common interpretation of signifier is that it represents an underlying concept or meaning, and since Applicant has never specified otherwise in the specification, to state otherwise is considered new matter.

By the present amendment, for the purpose of advancing prosecution and without prejudice or disclaimer, the term "signifier" has been removed from claim 1, and the definition of signifier, i.e., "an orthographic appearance of a word apart from the meaning of the word," has been employed directly. Accordingly, this ground of rejection has been overcome.

The factual inquiry in connection with the written description requirement is set forth as follows: "the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." MPEP 2163.02.

Furthermore, the "subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." *Id.* For the reasons described below, the present language of claims 1, 149-157 and 163-165 conveys with reasonable clarity to those skilled in the art that applicant was in possession of the invention as now claimed, and accordingly, the rejections are respectfully traversed.

As to claim 1, the Examiner takes the position that the specification fails to teach the limitation "providing the incentive...only if the indication as been determined to demonstrate the sufficient knowledge." The specification explicitly states, at page 21, lines 16-17, that the review must be verified for the incentive to be given. Moreover, one of ordinary skill in the art would clearly understand, upon reading the specification, that the incentive is provided only if sufficient knowledge is demonstrated. Otherwise, there is simply no reason to provide the incentive.

As to claim 149, the Examiner states that the specification does not disclose the conversion code being usable with the information from the parent independent claim. This rejection is respectfully traversed. As set forth on page 24, lines 12-19, and Fig. 3, the provided information contains signifiers; the information consumer notes the signifiers, uses a conversion code to reveal contact information, and is motivated by an incentive to use the contact information. One of ordinary skill in the art would immediately understand that the information provided by the consumer is reviewed to determine whether sufficient comprehension is indicated to provide the incentive.

The Examiner takes the position that each use of the term "embodiment" in the specification represents a separate embodiment, and that these embodiments are not

disclosed as being usable together. The Office Action cites no support in the regulations or case law for this position. One of ordinary skill in the art would clearly understand which variations or embodiments are usable together. For example, one of ordinary skill in the art reviewing the specification would understand that the various modes of communication set forth on page 23, lines 6-12, i.e., electronic mail, a telephone call, connection to a website, postal mailing, faxing or otherwise transmitting a written response, are not entirely separate from all other disclosure in the specification, as the Examiner apparently contends.

As to claim 150, the Examiner, similarly to claim 149, takes the position that each use of the term "embodiment" in the specification represents a separate embodiment, and that these embodiments are not disclosed as being usable together. As with claim 149, one of ordinary skill in the art would clearly understand which variations or embodiments are usable together.

As to claim 151, the Office Action states that the limitation "the instructions pertain to extracting information independent of the text form information in which the text form signifiers are inserted" fails to meet the written description requirement. While the Office Action states that nowhere in the specification is the "meaning" or "topic" of words discussed, there is no requirement that the wording of the claims be contained in the same terms, or *in haec verba*, in the specification. The extracting of such information is clear, for example, from the instruction to copy down a letter at the end of the word, without reference to the meaning of the sentence, as disclosed, for example, on page 22, lines 9-13.

As to claims 153-156 and 163-165, the Examiner takes the position that each use of the term "embodiment" in the specification represents a separate embodiment, and that these embodiments are not disclosed as being usable together. The rejection is traversed for the reasons set forth above with respect to claim 149.

For the reasons set forth above, reconsideration and withdrawal of the rejections of claims 1, 149-157 and 163-165 under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement, is respectfully requested.

Rejection of Claim 164 under 35 U.S.C. 112, second paragraph

Claim 164 stands rejected as using the limitation "and/or." By the present amendment, the limitation has been changed to recite "one or more of" and change "and/or" to "or."

Accordingly, this rejection has been overcome.

Rejection of Claims 1, 149-157, 164 and 165 under 35 U.S.C. 101

Claims 1, 149-157, 164 and 165 stand rejected under 35 U.S.C. 101.

By the present amendment, independent method claims 1 and 151 have been amended to recite performance of method steps by a computer. Disclosure support is found generally at page 41, line 12 to page 44, line 27, and Fig. 16.

Rejection of Claims 1 and 148-150 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,236,200 (McGregor).

Claims 1 and 148-150 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,236,200 (McGregor).

As to claim 1, the rejection is respectfully traversed on the grounds that McGregor fails to disclose or render obvious at least the following steps of amended claim 1:

- providing to the information consumer said information in text having a plurality of orthographic appearances of words apart from the meaning of the words;

- providing to the information consumer an use instruction for each of the orthographic appearances;

- receiving at a computer an indication from the information consumer;

- determining by the computer whether the indication received from the information consumer demonstrates sufficient knowledge of said orthographic appearances in accordance with said use instruction to provide an incentive to said information consumer;

- providing by the computer an indication to provide the incentive to said information consumer only if the indication has been determined to demonstrate the sufficient knowledge.

In contrast, the method of McGregor is summarized at col. 6, lines12-17, as follows:

In turn, the gift recipient, who is referred to herein as the seeker thereof, simply follows the clues contained on the front side of each dispensable element. The gift, or treasure, readily is found, much to the pleasure of hider and seeker, much to the joy of giver and receiver.

There is no step of receiving an indication from an information consumer, and no step of determining or providing an indication by a computer. Rather, the recipient of the card of McGregor simply follows the clues to obtain a treasure.

The Office Action argues, in Paragraph 8, that the claim interpretation is open to the possibility of anyone performing any and all steps. Amended claim 1 is clear that a

computer receives the indication from the information consumer, determines whether the indication received from the information consumer demonstrates sufficient knowledge of said orthographic appearances, and provides an indication to provide the incentive to said information consumer only if the indication has been determined to demonstrate the sufficient knowledge.

Applicant respectfully disagrees with the Examiner's interpretation of McGregor. The Examiner states that an onlooker watching someone who is using the invention of McGregor would be able to readily tell that the user was able to understand the clues. However, in McGregor, at col. 6, lines 12-17, it is made clear that the gift recipient follows the clues until finding the gift or treasure. As McGregor does not teach an onlooker, the Examiner is modifying McGregor to add an onlooker. Such a modification is clearly not proper in a Section 102 rejection, and the Examiner has provided no basis for modification of McGregor under Section 103.

Furthermore, even if McGregor were modified as proposed by the Examiner to add an onlooker, McGregor does not teach a step of "providing by the computer an indication to provide the incentive to said information consumer only if the indication has been determined to demonstrate the sufficient knowledge."

Furthermore, McGregor fails to disclose the recited orthographic appearances and use instructions as recited in claim 1. McGregor discloses instructional messages and task-setting messages, as described at col. 2, line 63 to col. 3, line 26, but not the recited orthographic appearances and use instructions. There is nothing in McGregor to suggest, for example, an orthographic appearance of a word apart from the meaning of the word.

For at least the foregoing reasons, the rejection of claim 1 as anticipated by McGregor should be withdrawn.

The rejection of claims 149-150 as anticipated by McGregor should be withdrawn at least by virtue of the dependence of these claims from base claim 1.

In addition, as to claim 149, the recited conversion code for conversion of signifiers is not met by the language "anagrams and puzzles" of McGregor. For example, McGregor provides no indication or suggestion that the anagrams or puzzles are based on orthographic appearances.

As to claim 150, McGregor clearly does not include any contact information for claiming an incentive. McGregor provides the location of a treasure by following steps. The Examiner reads the limitation "contact information" as taught by the anagrams and puzzles of McGregor. (Office Action, page 11) It is an unreasonably broad reading of the limitation "contact information" to regard this phrase as encompassing puzzles and anagrams, as proposed by the Examiner.

For these additional reasons, at least, the rejections of claims 149-150 should be withdrawn.

Rejection of Claims 151-155 and 163-165 under 35 U.S.C. 102(a) as being anticipated by Sony Owner's Manual, Sony Video Cassette Recorder Model SLV-662HF, 1999.

Claims 151-155 and 163-165 stand rejected under 35 U.S.C. 102(a) as being anticipated by Sony Owner's Manual, Sony Video Cassette Recorder Model SLV-662HF, 1999 ("Sony").

The rejection of claim 151 is respectfully traversed for at least the reason that Sony fails to disclose the steps of:

providing said text form information having a plurality of text form signifiers inserted therein typeset consistently with the text form information, and text form instructions identifying the signifiers, wherein the instructions pertain to extracting information independent of a meaning of the text form information in which the text form signifiers are inserted;

receiving by a computer an indication from the information consumer; and

verifying by the computer the information consumer's review of the text form information by determining, based on the indication received from the information consumer, whether sufficient knowledge of the text form signifiers has been demonstrated by the information consumer, wherein the sufficient knowledge includes knowledge of signifiers in plural separated locations in the text form information.

Sony does not disclose providing text form information having text form signifiers inserted therein typeset consistently with the text form information, text form instructions identifying the signifiers, wherein the instructions pertain to extracting information independent of a meaning of the text form information in which the text form signifiers are inserted. The Office Action argues, on page 12, that the Sony instructions do not teach one how to use a VCR and therefore the instructions are independent of the meaning of the text form information. Applicant respectfully disagrees with this

interpretation of the claim language. The text in question in Sony is not independent of the meaning of the text, as the text in question in Sony has the meaning of providing a toll free telephone number. The Examiner's position, which appears to be that the claim language is met if the text in question does not teach the overall topic of a document, is not a reasonable interpretation of the language of claim 151.

The Examiner's interpretation of "plural separated locations" is similarly unreasonable. The Examiner takes the position that adjacent numerals meet this claim limitation (Office Action, page 12). This position is not a reasonable reading of the wording "plural separated locations." In prosecution, claims may be given a broadest reasonable interpretation "consistent with the interpretation that those skilled in the art would reach." MPEP 2111. To suppose that adjacent numerals meet the claim language "plural separated locations" is simply not a reasonable interpretation.

For at least the foregoing reasons, the rejection of claim 151 should be withdrawn.

The rejections of claims 152 -155, 163 and 165 under Section 102(a) as anticipated by Sony should be withdrawn at least by virtue of the dependence of these claims from base claim 151.

Claim 164 recites, inter alia, "the signifiers enabling the information consumer to engage in one or more of the removal, application and repositioning of elements on the article, to reveal information." The Examiner argues that, as the signifiers do not prevent the flipping of pages, the signifiers enable the information consumer to reveal

information. The equating of "enabling" with "not preventing" is clearly not a reasonable interpretation of the limitation.

For this additional reason, in addition to its dependence from allowable base claim 1, claim 164 is allowable.

Rejection of Claims 151, 156 and 157 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 3,926,325 (Benson).

Claims 151, 156 and 157 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 3,926,325 (Benson).

The rejection is respectfully traversed.

Amended claim 151 includes the limitations:

providing said text form information having a plurality of text form signifiers inserted therein typeset consistently with the text form information, and text form instructions identifying the signifiers, wherein the instructions pertain to extracting information independent of a meaning of the text form information in which the text form signifiers are inserted;

receiving by a computer an indication from the information consumer; and

verifying by the computer the information consumer's review of the text form information by determining, based on the indication received from the information consumer, whether sufficient knowledge of the text form signifiers has been demonstrated by the information consumer, wherein the sufficient knowledge includes knowledge of signifiers in plural separated locations in the text form information.

Benson fails to disclose text form signifiers and instructions as recited. Rather, Benson displays instructions that do not pertain to extracting information independent of a meaning of the text form information. There is nothing in Benson teaching "wherein the instructions pertain to extracting information independent of a meaning of the text form information in which the text form signifiers are inserted." The Office Action argues, on

page 13, that the wording "For general use" and "For child-protective use" shown, for example, in Fig. 3 of Benson, is independent of the meaning of the text form information. However, these words clearly have meaning conveyed by the text form information.

The Examiner attempts to interpret the limitation "receiving an indication from the information consumer" in an unreasonable manner to include receiving by the consumer himself or by an onlooker. Similarly, the Examiner unreasonably attempts to interpret the step of verifying as performed by the information consumer or an onlooker. As amended, claim 151 recites that the steps of receiving and verification are performed by a computer.

For at least the foregoing reasons, the rejection of amended claim 151 as anticipated by Benson should be withdrawn.

The rejection of claims 156-157 should be withdrawn at least by virtue of the dependence of those claims from claim 151.

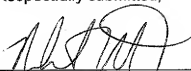
It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any

claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

CONCLUSION

Having fully addressed the Examiner's objections and rejections it is believed that, in view of the preceding amendments and these remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited.

Respectfully submitted,



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